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In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 512

UGO MONACO AND MONTECATINI
SOCIETA GENERALE PER L'INDUSTRIA
MINERARIA E CHIMICA ANONIMA,

Petitioners,

v.

ROBERT C. WATSON,
Commissioner of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals For the District of Columbia.

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In the Supreme Court of the United States

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ROBERT C. WATSON,
Commissioner of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI To the United States Court of Appeals For the District of Columbia.

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia, which was entered in the above entitled case on August 27, 1959.

CITATIONS TO OPINIONS BELOW.

The opinion of the Court of Appeals for the District of Columbia, printed in the Appendix hereto at page 1a, is unreported. The United States District Court for the District of Columbia wrote no opinion, except the memorandum and order which are printed in the Appendix hereto at pages 5a and 6a. The memorandum opinion of the Commissioner of Patents is unreported and is printed in the Appendix hereto at pages 7a-10a.

JURISDICTION.

The judgment of the Court of Appeals was entered on August 27, 1959, and is printed in the Appendix at page 4a. The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254(1).

THE CONFLICT OF DECISION.

The Court of Customs and Patent Appeals says, "The issuance of a patent must wait until the Patent Office and Courts determine who is the right inventor." *In re Allen*, 115 F. 2d 936 (CCPA, 1940).

The Court of Appeals of the District says, to the contrary, "The Patent Office does not have to wait, even though the same patent will be issued on the same invention to two separate inventors," Judge Burger dissenting, in *Ugo Monaco and Montecatini Societa Generale per l'Industria Minerari E Chimica Anonima vs. Robert C. Watson, Commissioner of Patents*, App. D. C., No. 14,937. (1959).

QUESTION PRESENTED.

There is **diversity of opinion between two Courts of Appeals of the United States** on the following question, said by the Patent Office Manual to be of "transcendent importance" to the integrity of the United States Patent System, i.e. who is the first inventor to whom the patent should be granted? The question is:

Can the United States Patent Office legally issue two separate patents for the same invention to two different inventor contestants in a Patent Office Interference, involving the question of who is the first inventor, without awaiting the final decision of the reviewing courts as to who, after final determination, is the inventor and who should receive the patent?

CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS INVOLVED.

The constitutional provision involved herein is Art. I, Section 8, Cl. 8. The Statutes involved are: 35 U. S. C., Sections 135, 141 and 146; and 5 U. S. C., Section 1009(d). The constitutional provision and statutes are printed in the Appendix at pages 10a-13a.

STATEMENT OF THE CASE.

A. HOW THE QUESTION AROSE.

The Patent Office withholds issue of the patent if the appeal is to the Court of Customs and Patent Appeals. It declines to do so if the appeal is to the United States District Court for the District of Columbia. We do not know any sound reason for this serious discrimination.

The petitioner Montecatini* and its inventor, Monaco, are citizens of Italy. They have a Patent Office Interference with a citizen of the United States, Hoffman. The Patent Office decided adversely to Montecatini and Monaco. That decision is now awaiting review in the United States District Court of the District of Columbia under Section 146 of the Patent Code which requires that a foreigner can only secure a review of an adverse Patent Office decision in the District Court of the District of Columbia and its Court of Appeals. The Court of Customs and Patent Appeals, pursuant to its decision of *In re Allen*, 115 F. 2d 936 (CCPA 1940) holds that, as the appeal to it from the final decision of the Patent Office in the Patent Office Interference is to determine who is the first inventor, the Patent Office must suspend the issuance of the patent until that Court can determine who is the first and original inventor.

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* Full names on page 2.